

U.S. Appln. No. 09/368,670
PRELIMINARY AMENDMENT AND
RESPONSE TO RESTRICTION REQUIREMENT

hereby elect with traverse to prosecute in this application the subject matter of Group 2, claims 1-66, 73, 74, 76, 77, 79, 80, 82, 85, 86, 87, 88 and 96, drawn to compounds in which $a=0$, $b=0$ and $Q = -N-Y-$. Although not indicated by the Examiner in the Restriction Requirement, Applicants believe that claims 79, 80, 85, 87 and 88 are properly included in the elected Group 2. In addition, Applicants believe that claim 82 should not be included in Group 3.

In response to the election of species requirement, Applicants hereby elect the compound number 633 shown in Table 6 in the specification.

Applicants reserve the right to prosecute in one or more divisional applications whatever subject matter is not allowed here. However, Applicants respectfully request that the Examiner reconsider and withdraw or modify the restriction requirement for the reasons given below.

Applicants submit that Groups 2, 6, 10 and 14 are all sufficiently related such that the search for one group would be at least partially coextensive with another and thus, not an undue burden on the Examiner. In searching the subject matter of Group 2, related to peptide compounds, concurrently one would also be searching the prior art relevant to the respective process of preparation, method of treatment and binary mixtures of Groups 6, 10 and 14, all of which recite or utilize the compounds of Group 2.

Also, Applicants point out that if they are forced to file several divisional

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applications, such divisional applications would incur additional expense and a shorter patent term than if all the noted Groups were examined in this application together.

In short, the burdens placed on Applicants by this restriction requirement are great whereas the actual undue burden placed upon the Examiner is unclear. In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this restriction requirement with respect to Groups 2, 6, 10 and 14.

In any case, Applicants appreciate the Examiner's indication that in the event that a group drawn to compounds per se (e.g., Group 2) is elected and found allowable, the claims drawn to a method of making or using the compounds will be rejoined for allowance or at least further examination, in accordance with MPEP § 821.04 and *In re Ochiai*, 37 USPQ 2d 1127 (Fed. Cir. 1995). Applicants also appreciate the Examiner's indication that it is likely that the claim drawn to a binary mixture will also be rejoined in the event that a group drawn to compounds per se (e.g., Group 2) is elected and found allowable. Accordingly, Applicants respectfully request rejoinder of Groups 6, 10 and 14 in the event that the compounds of Group 2 are found allowable.


With respect to the election of species requirement, Applicants respectfully submit that the standard practice regarding Markush-type claims (discussed in MPEP § 803.02) should be followed in the present application since Markush-type

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claims are presented. That is, if the elected species (compound 633) is found to be allowable, the search and examination should be extended to non-elected species within elected Group 2. In that case, the Examiner is respectfully requested to delineate the extent of the examination as to the elected and non-elected species.

If any questions should arise regarding the present application, the Examiner is kindly requested to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,




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